

REMARKS

Claims 12-17 and 20-23 are pending in the application.

Claims 12 is amended above to further distinguish the claimed invention from the prior art. In particular claim 12 is amended to include a range of metal layer thickness and claim 12 is amended to include the features of claims 15-16.

Claim 17 is amended to include a range of thickness of the trim piece and to broaden the types of adhesives claimed.

Claims 15-16 have been cancelled from the application without prejudice.

No new matter has been added to the application by way of these specification and claim amendments.

The examiner's specification and claim rejections and objections are overcome or they are traversed as set forth below.

I. THE ANTICIPATION REJECTIONS

The examiner has lodged the following novelty rejections against the pending application claims.

- The examiner rejected claims 12-16 for being anticipated by Tanikita et al. (Tanikita) (USP 5,833,889).
- The examiner rejected claims 12-15 for being anticipated by Marton et al. (Marton)(USP 4,241,129).

Each of these rejections is traversed or they are overcome as set forth below.

A. Claims 12-16 Are Not Anticipated By Tanikita

Independent claim 12 is amended above to limit the thickness of the shaped metal layer to from 0.005 to about 0.025 inches. This amendment finds support in the specification at page 11, line 13. A thickness range of from 0.005 to about 0.025 inches corresponds to from about 127,000 angstroms to about 6,350,000 angstroms.

Tanikita discloses an article having a metal thickness of 1000 angstroms. Claims 12-16 are not anticipated by Tanikita at least because Tanikita does not disclose an article having a metal layer with the presently claimed thickness range.

B. Claims 12-15 Are Not Anticipated By Marton

The examiner rejected claims 12-15 for being anticipated by Marton. The examiner notes that Marton discloses an article with a metal layer having a thickness of 1 micrometer. 1 micrometer corresponds to 0.000039 inches.

Claim 12 is amended above to limit the thickness of the metal layer to from 0.005 inches to about 0.025 inches. This range falls well outside of the metal thicknesses of the Marton articles. Claims 12-15 are, therefore, novel because Marton does not disclose an article having the now claimed metal thickness range.

II. TRAVERSE OF THE OBVIOUSNESS REJECTIONS

The examiner has lodged the following novelty rejections against the pending application claims.

1. The examiner rejected claim 15 for being unpatentable for obviousness over Tanikita.
2. The examiner rejected claim 17 for being obvious over Tanikita in view of Hashimoto (JP01-114407).
3. The examiner rejected claim 16 for being obvious over Marton (USP 4,241,129) in view of Tanikita.
4. The examiner rejected claim 17 for being obvious over Marton in view of Hashimoto.
5. The examiner rejected claims 12-14 and 17 for being obvious over Sweeny (EP 0376010) in view of Marton.
6. The examiner rejected claim 15 for being obvious over Sweeny in view of Marton and in further view of Luch (USP 4,429,020).
7. The examiner rejected claim 16 for being obvious over Sweeny in view of Marton and further in view of Tanikita or Grefenstein et al. (PCT/EP00/05755).
8. The examiner rejected claims 20-23 for being obvious over Bowen (GB 2027636) in view of Vuilleumier (USP 5,220,541).

A. Rejections 1, 3 And 6-8 Are Overcome By The Claim 12 Amendment

Claim 12 is amended above to recite an article with a metal layer that has a thickness ranging from 0.005 to about 0.025 inches. This amendment overcomes obviousness rejections 1,

3 and 6-7 because the rejected claims depend upon independent claim 12 which is novel and patentable for the reasons recited in Section I above.

B. Claims 12-14 Are Not Obvious Over Sweeney in View Of Marton

Claim 12 is amended above to include the features of claims 16-17. The amendment renders as moot the examiner's rejection of claims 12-14 over Sweeney in view of Marton.

C. Claim 17 Is Patentable Over Tanikita In View Of Hashimoto

Claim 17 is amended above as with claim 12 to include a range of thicknesses for the metal layer. The examiner appears to rely upon Tanikita in this rejection for disclosing the claimed metal layer thickness. As noted in Section I(A) above, the Tanikita metal layer thickness now falls well outside of the claimed ranged. For at least this reason, claim 17 is non-obvious and patentable over Tanikita in view of Hashimoto.

D. Claim 17 Is Patentable Over Marton In View Of Hashimoto

Claim 17 is amended above as with claim 12 to include a range of thicknesses for the metal layer. The examiner appears to rely upon Marton in this rejection for disclosing the claimed metal layer thickness. As noted in Section I(B) above, the Marton metal layer thickness now falls well outside of the claimed ranged. For at least this reason, claim 17 is non-obvious and patentable over Marton in view of Hashimoto.

E. Claim 17 Is Patentable Over Sweeny In View Of Marton

Claim 17 is amended above to recite thickness ranges for the overall trim piece. Support for this amendment is found at page 12 line 10. Amended claim 17 is non-obvious and patentable at least because the prior art does not disclose the claimed overall trim piece thickness.

F. Claims 20-23 Are Not Obvious

The examiner rejected claims 20-23 for being obvious over Bowen (GB 2027636) in view of Vuilleumier (USP 5,220,541). It is the examiner's position that Bowen discloses all of the elements of claims 20-23 except for "a feature formed on the insert outside of the resin feature formed in the holes". The examiner relies upon Vuilleumier for supplying this missing teaching. In particular the examiner states that the features on the dial plate supply this teaching.

Claims 20-23 are non-obvious and patentable because:

- Vuilleumier does not disclose the claimed "at least one feature formed in the insert". What Vuilleumier discloses is a feature formed "on" the watch face. This is not the same

as a feature formed “in the insert” which is the case of Vuilleumier would be a feature formed in the watch face. Such feature forming “in the insert” is shown, for example, in Figure 12B where features 74 are formed in the insert during extrusion by resin forcing the insert into cavities 68 in the mold. Vuilleumier discloses no such features and claims 20-23 are non-obvious and patentable because the examiner has not made out a prima facie case of obviousness.

- Claim 21 is independently patentable because the cited prior art does not disclose a piece wherein the insert is a preformed skin or a preformed metal.
- Claim 22 is independently patentable because the cited prior art does not disclose a piece in which the insert is a combination of a preformed skin layer and a preformed metal layer.

CONCLUSION

Claims 12-14, 17 and 20-22 are believed to be patentable over the prior art. Favorable reconsideration and allowance of all pending application claims is, therefore, courteously solicited.

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